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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,922	03/24/2004	Kenji Akahoshi	16869S-111700US	8046

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EXAMINER	
DANIELSEN, NATHAN ANDREW	

ART UNIT	PAPER NUMBER
2627	

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10/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/808,922	AKAHOSHI ET AL.	
	Examiner	Art Unit	
	Nathan Danielsen	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 July 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-7 and 10-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-7 and 10-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *05/05/08*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1, 3-7, and 10-14 are pending. Claims 2, 8, 9, 15, and 16 were canceled in applicant's amendment filed 14 August 2007.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-7, 10-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, it is unclear what portion of applicant's specification provides proper antecedent basis/support for the limitation "wherein the area is an area where light returned from said optical disk is not substantially detected" since, as best understood by the examiner, a very small amount of light irradiated on *any part* of the disclosed/claimed optical disk in the disclosed defocused state would be returned and detected by the disclosed/claimed apparatus. Therefore, this limitation as construed as new matter and is hereby rejected accordingly. Claims 3-6 and 10-12 are rejected as containing new matter based on their dependence to claims containing new matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fennema et al (US Patent 5,425,013; hereinafter Fennema), in view of Osakabe (US Patent Application Publication 2002/0150394), and further in view of applicant's admitted prior art (hereinafter the AAPA).

Regarding claim 13, Fennema discloses a method of recording data on a recordable optical disk, the method comprising:

irradiating the laser beam on an inner-peripheral mirror area for the purpose of adjusting laser power (col. 3, lines 20-25).

However, Fennema fails to disclose where the optical disk has a power calibration area and a recording management area on an inner periphery of the recordable optical disk, where the inner-peripheral mirror area is an area located radially inwardly of the power calibration area and the recording management area, and where the area is an area where light returned from said optical disk is not substantially detected.

In the same field of endeavor, Osakabe discloses where the optical disk has a power calibration area (element 22 in figure 3) and a recording management area (element 24 in figure 3) on an inner periphery of the recordable optical disk (note the locations of elements 22 and 24 with respect to the position of element 12 in figure 3), and where the inner-peripheral mirror area is an area located radially inwardly of the power calibration area and the recording management area (note the position of elements 18 and 32 with respect to the positions of element 22 and 24 in figure 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the optical disk of Fennema with the structure of the optical disk of Osakabe,

for the well-known purpose of providing the optical disk with inter-device compatibility (suggested by at least ¶s 7, 26, and 37).

However, Fennema in view of Osakabe also fail to disclose where the area is an area where light returned from said optical disk is not substantially detected.

In the same field of endeavor, the AAPA discloses where the area is an area where light returned from said optical disk is not substantially detected (page 3, lines 4-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the functionality of the optical disk disclosed by Fennema and Osakabe with that of the AAPA, for the purpose of avoiding the accidental recording of data on the recordable surface during power calibration (page 3, lines 4-15).

6. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fennema, in view of Wang et al (US Patent Application Publication 2002/0110065; hereinafter Wang), and further in view of AAPA.

Regarding claim 14, Fennema discloses a method of recording data on a recordable optical disk, the method comprising:

irradiating the laser beam on a mirror area, where the laser beam is not irradiated on the power calibration area for the purpose of adjusting laser power (col. 3, lines 20-25).

However, Fennema fails to disclose where the recordable optical disk has a power calibration area on an outer periphery of the recordable optical disk, and an area located radially outwardly of the power calibration area and where the area is an area where light returned from said optical disk is not substantially detected.

In the same field of endeavor, Wang discloses where the recordable optical disk has a power calibration area on an outer periphery of the recordable optical disk, and an area located radially outwardly of the power calibration area (elements 52 and 48, respectively, in figure 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the optical disk of Fennema with the layout of the disk of Wang, for the purpose of obtaining optimum recording powers for the entire disk (¶s 6 and 7).

However, Fennema in view of Wang also fail to disclose where the area is an area where light returned from said optical disk is not substantially detected.

In the same field of endeavor, the AAPA discloses where the area is an area where light returned from said optical disk is not substantially detected (page 3, lines 4-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the functionality of the optical disk device of Fennema and Wang with that of AAPA, for the purpose of avoiding the accidental recording of data on the recordable surface during power calibration (page 3, lines 4-15).

Response to Arguments

7. Applicant's arguments with respect to claims 13 and 14 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

8. Claims 1 and 7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 1st paragraph, set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record, either alone or in combination, fails to teach or fairly suggest, in claims 1 and 7, the claimed invention as interpreted under the requirements of 35 U.S.C. 112, 6th paragraph, including control means controlling the objective lens driving means to defocus the beam and irradiate it in a defocused state on the area located radially inward of an inner PCA area or radially outward of on outer PCA area while monitoring an emitted beam by means of a monitoring photodiode.

Closing Remarks/Comments

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Danielsen whose telephone number is (571)272-4248. The examiner can normally be reached on Monday-Friday, 9:00 AM - 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A.L. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nathan Danielsen
10/24/2008

/Andrea L Wellington/
Supervisory Patent Examiner, Art Unit 2627